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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
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09/289,000 02/25/97 BLATT

G 16683-1-2

EXAMINER
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TWO EMBARCADERO CENTER, 8TH FLOOR  
SAN FRANCISCO, CA 94105

DM12/0707

ART UNIT	PAPER NUMBER
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3738  
DATE MAILED:

07/07/00

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on May 1, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three (3) month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-6, 8-10, + 24-26 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-6, 8-10, and 24-26 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application for \_\_\_\_\_

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*Specification*

The disclosure is objected to because of the following informalities:

On page 7, line 27, "2C" should be changed to as ---3C---.

Appropriate correction is required.

*Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-6, 25 and 26 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The language added to the present claims constitutes new matter which lacks original support because the sliding motion, as originally disclosed, is not between the face and the first joint surface but between the face and the second or unresected joint surface. Since the method of this claim only provides a resection of the first joint surface, the claiming of a slidable contact of the face with the first surface is not provided for in the original specification.

In reference to claim 1, for example, the language of lines 9-10 "while permitting slidable motion between the face and the first joint surface" and lines 5-6 "implant having a face adapted

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to face the removed portion of the joint surface” is not in agreement with the original specification wherein at least both joint surfaces need to be removed in this arrangement; see original claim 8 and Figures 1A-1F, 2, and 3A-3F.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6, 25 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Since the method of this claim only provides a resection of the first joint surface, the claiming of a slidable contact of the face with the first surface is indefinite and not understood.

*Claim Rejections Based Upon Prior Art*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1, 4-6, 8-10, and 24-26 are rejected under 35 U.S.C. 102(b) as anticipated by Cohen (US 5,207,712) or, in the alternative, under 35 U.S.C. 103(a) as obvious over Cohen (US 5,207,712) alone. Cohen (US 5,207,712) anticipates the claim language wherein the resection of bone ends or the holes drilled into the bone ends expose the cancellous bone surface and the solid sphere and rods allow both for the joint to flex and extend after implantation (see Col. 4, lines 38 and 39) and the ball (4) provides a sliding surface for the joint ends; see the whole document, especially Col. 3, lines 18-20; Col. 4, lines 3-39 and Figures 1-3 and 8-11.

Alternatively, one could view the ball (4) as not providing a sliding surface because it is not explicitly stated as providing such. However, the Examiner posits that one viewing this embodiment would be led to the conclusion that the ball (4) obviously functions as a stop and sliding surface for the resected bone ends.

With regard to claims 8 and 9, Applicant is directed to Figure 1 and especially Figure 2 for claim 8.

With regard to claim 24 specifically, the Examiner posits that a period of 6 to 7 months would be sufficient to allow all the natural processes of the permitting step as claimed to take place; see Col. 2, lines 45-48.

With regard to claims 4, 10, and 25 specifically, the estimating step as claimed is inherently or implicitly present in Cohen who makes his device for a particular joint type so that as much regrowth between the joints can take place.

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Claims 2 and 3 are rejected under 35 U.S.C. § 103 as being unpatentable over Cohen (US 5,207,712) in view of Delcommune et al (US 5,007,939). Cohen meets the claim language except for the use of lactic acid polymer or copolymer as claimed. Delcommune et al, however, teaches that it has been known to use lactic acid polymer or copolymer for resorbable bone repair devices. Hence, it is the Examiner's position that it would have been obvious to one of ordinary skill in the art to use lactic acid polymer or copolymer in place of in addition to the polymer of Cohen for the same reasons that Delcommune et al uses the same and in order to further reduce the cost of making the device.

#### *Response to Arguments*

Applicant's arguments filed May 1, 2000 have been fully considered but they are not persuasive.

With regard to the argument that sliding motion is prevented by Cohen, the Examiner respectfully disagrees and takes the position that since the joint can flex and extend with the implant in place (see Col. 4, lines 38-39) that sliding on the ball (4) face would occur. Furthermore, the claims do not require sliding motion between the joint ends as argued only sliding between the face(s) and the joint end(s).

In response to the argument that formation of fibroblast and fibrocartilage is conditioned on joint motion, the Examiner asserts that this process would also occur in the Cohen healing process because joint motion is also provided thereby as pointed out above.

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*Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Prebilic whose telephone number is (703) 308-2905. The examiner normally be reached on Monday-Thursday from 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin, can be reached on (703) 308-1065. The fax phone number for this Technology Center is (703) 305-3580.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 3700 receptionist whose telephone number is (703) 308-0858.



Paul Prebilic  
Primary Examiner  
Art Unit 3738